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EXAMINER

COLLINS, MICHAEL

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/732,925
Filing Date: December 10, 2003
Appellant(s): MCDANIEL ET AL.

MAILED

AUG 22 2007

GROUP 3600

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For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/10/2007 appealing from the Office action mailed 10/13/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The claim rejections are substantially correct.

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner.

Claim 32 is not rejected under 35 U.S.C. 102(e) as being anticipated by Borrero (USP 6,799,695).

Claims 14,15, 20, 21, 23, 24, and 27-30 are not rejected under 35 U.S.C. 103(a) as being unpatentable over Borrero (USP 6,799,695) in view of Peebles (USP 3,343,716)..

Claim 22 is not rejected under 35 U.S.C. 103(a) as being unpatentable over Borrero (USP 6,799,695) in view of Peebles (USP 3,343,716) and further in view of Yamada (USP 5,704,471).

Claim 25 is not rejected under 35 U.S.C. 103(a) as being unpatentable over Borrero (USP 6,799,695) in view of Peebles (USP 3,343,716) and further in view of Pehr (USP 6,349,849).

Claim 26 is not rejected under 35 U.S.C. 103(a) as being unpatentable over Borrero (USP 6,799,695) in view of Peebles (USP 3,343,716) and Pehr (USP 6,349,849) as applied to claim 25 above; and further in view of Amundson et al (USP 6,604,651).

Claim 31 is not rejected under 35 U.S.C. 103(a) as being unpatentable over Peebles (USP 3,343,716) in view of Borrero (USP 6,799,695).

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,799,695	Borrero	9-2002
5,704,471	Yamada	9-1995
6,349,849	Pehr	6-2000
6,604,651	Amundson et al.	3-2001

3,343,716

Peebles

3-1966

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-32 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The applicant discloses, "said body configured with an exterior surface that is **ergonomically shaped to generally conform** to being carried and held in one hand of the user...." which seems to be some type of size range critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). This size range is not disclosed within the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. What is an ergonomically shaped exterior surface? What does generally conform mean?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1-5, 7, 8, 11-13, and 16-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Borrero (USP 6,799,695).

Regarding claim 1, Borrero discloses a portable carrying case for personal care absorbent articles, comprising:

- a body (10), said body defining an internal enclosure for receipt of a plurality of stacked personal care absorbent articles (12), said body configured with an exterior surface that is ergonomically shaped to generally conform to being carried and held in one hand of the user while the user's other hand removes an article from the internal enclosure
- an opening (48) defined in said body (10) at a location so as to at least partially expose an upper one of said absorbent articles (12) for dispensing without generally exposing underlying absorbent articles (12)
- a lid (46) movably disposed relative to said body (10) from a closed position wherein said opening (48) is covered by said lid (46) to an open position wherein access is provided to said absorbent articles through said opening (48)

- a manual push structure (32 and 42) defined in said body generally opposite from said opening (48), said push structure (32 and 42) configured to allow a user to push on the bottommost one of said stacked absorbent articles (12) so as to move the uppermost one of said stack of absorbent articles (12) towards said opening (48) for grasping and retrieval by the user.

Regarding claim 2, Borrero discloses an absorbent article carrying case as in claim 1, and further discloses a body comprising a multi-sided structure (10) including a first wall and a second wall disposed opposite said first wall, said opening (48) defined in said first wall (22) and said push structure (32 and 42) defined in said second wall (30) [the push structure defined in the second wall may be positioned to be opposite of the first wall].

Regarding claim 3, Borrero discloses the absorbent article carrying case as in claim 2, and further discloses a multi-sided structure comprising a front wall (22), a back wall (30), and circumferential sides walls (24 and 26) so as to define an elongated box-like structure, said opening (48) defined in said front wall (22) and said push structure defined in said back wall (30).

Regarding claim 4, Borrero discloses the absorbent article carrying case as in claim 3, and further discloses circumferential side[[s]] walls (24 and 26) that define a closed perimeter of said enclosure in said open and closed positions of said lid (46) such that said absorbent articles (12) cannot be slid out of said body and are removed by the user by pulling on said uppermost article in a direction generally transverse to a plane of said opening (48).

Regarding claim 5, Borrero discloses the absorbent article carrying case as in claim 1, and further discloses a lid (46) that is pivotal relative to said body (10).

Regarding claim 7, Borrero discloses the absorbent article carrying case as in claim 1, and further discloses a body (10) comprising a shape generally conforming to an outline of said absorbent articles (12) carried therein.

Regarding claim 8, Borrero discloses the absorbent article carrying case as in claim 1, and further discloses a push structure (32 and 42) comprising an access opening defined through a wall of said body, said access opening having a restricted size so as to prevent removal of said bottommost article through said access opening (see Figures 2 and 3).

Regarding claim 11, Borrero discloses the absorbent article carrying case as in claim 1, and further discloses a push structure (32 and 42) comprising a resilient portion of a wall (30) of said body generally opposite from said opening (48).

Regarding claim 12, Borrero discloses the absorbent article carrying case as in claim 1, and further discloses a viewing window (32 and 34) such that a user can ascertain the contents of said body (10) without opening said lid (46).

Regarding claim 13, Borrero discloses the absorbent article carrying case as in claim 12, and further discloses a window (32 and 34) that is incorporated with said push structure (32 and 36).

Regarding claim 16, Borrero discloses the absorbent article carrying case as in claim 1, and further discloses a lid (46) defining at least a portion of a front wall (22) of

said body (10) in said closed position such that said opening (48) is defined in said front wall (22) upon said lid (46) being moved to said open position.

Regarding claim 17, Borrero discloses the absorbent article carrying case as in claim 1, and further discloses a stack of said personal care absorbent articles (12) carried in said body (10).

Regarding claim 18, wherein said personal care absorbent articles comprise one of sanitary napkins, pantliners, tampons, and interlabial devices, the MPEP states:

§ 2115 [R-2] Material or Article Worked Upon by Apparatus

MATERIAL OR ARTICLE WORKED UPON DOES NOT LIMIT

APPARATUS CLAIMS

“Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim.” Ex parte Thibault, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, “[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims.”

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Borrero (USP 6,799,695) in view of Yamada (USP 5,704,471). Borrero discloses the absorbent article carrying case as in claim 1. However, he does not disclose a lid that is slidable relative to the said body. Yamada discloses a lid that is slidable relative to the said body for the purpose of covering and uncovering the tissue-dispensing opening (see column 2 lines 20-21). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify Borrero by including a lid that is slidable relative to the said body, as disclosed by Yamada, for the purpose of covering and uncovering the tissue dispensing opening.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Borrero (USP 6,799,695) in view of Pehr (USP 6,349,849). Borrero discloses the absorbent article carrying case as in claim 8. However, he does not disclose an access opening that is covered by an elastic material. Pehr discloses an access opening that is covered by an elastic material for the purpose of allowing a user to extend their hands inside the opening to withdraw a tissue (see column 3 lines 54-64). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify Borrero by including an access opening that is covered by an elastic material, as disclosed by Pehr, for the purpose of allowing a user to extend their hands inside the opening to withdraw a tissue.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Borrero (USP 6,799,695) in view of Pehr (USP 6,349,849) and in further view of Amundson et al. (USP 6,604,651). Borrero in view of Pehr discloses an absorbent article carrying

case as in claim 9. However, Pehr does not disclose the elastic material to be translucent. Amundson et al. discloses the elastic material to be translucent for the purpose of providing an indication of quantity of wipes remaining in the package (see column 2 lines 46-49). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify Pehr by using translucent elastic material, as disclosed by Amundson et al., for the purpose of providing an indication of the quantity of wipes remaining in the package.

(10) Response to Argument

Applicant's arguments filed 5/10/2007 with respect to HEADINGS A-I have been fully considered but they are not persuasive.

HEADING A: Claims 1-18 and 20-32 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The applicant discloses, "said body configured with an exterior surface that is **ergonomically shaped to generally conform** to being carried and held in one hand of the user...." which seems to be some type of size range critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). This size range is not disclosed within the specification.

In response the applicant discloses, "Enablement under Section 112, first paragraph, is approached from the perspective of the person of ordinary skill... Accordingly, the patentee is not required to include in the specification information readily understood by practitioners, lest every patent be required to be written as a

Art Unit: 3651

comprehensive tutorial and treatise for the generalist, instead of a concise statement for persons in the field... Moreover, open ended claims are not inherently improper and may be supported if there is an inherent, albeit not precisely known, upper limit and the specification enables one of skill in the art to approach that limit... Thus in the present case, it becomes self-evident that the range of hand sizes to be served is well within the knowledge of the person of ordinary skill... Moreover, applicant's disclosure equally well informs the person of ordinary skill that targeting any niche of the population is also possible by conforming the size of the case accordingly.. it is said that a picture is worth a thousand words.. embodiments of the claimed device are illustrated... For the reasons above applicants respectfully submit that claims 1-18 and 20-32 are enabled in accordance with 35 U.S.C. 112, first paragraph."

Rule: Structure critical or essential to the practice of the invention included in the claim(s) must be enabled by the disclosure.

Analysis: In claims 1 and 20, the applicant describes the invention in terms of a particular user. The claims are directed toward a surface that is ergonomically shaped to generally conform. Ergonomics is intended to maximize productivity and increase efficiency by reducing fatigue and/or discomfort by fitting a product to a person. Therefore, whether a device falls within the scope of the claims cannot be ascertained until a particular user engages the device. Consequently, the claims are indefinite and the scope of enablement is not established because a person of ordinary skill is not enabled to make this ergonomic device unless a particular user with particular dimensions, not disclosed in the specification, engages the device in order to fit the

product to the person. If the device being claimed is enabled to be ergonomic to one particular user, then it could not be enabled to be ergonomic to another user when using the product decreases another user's efficiency. Ex parte Brummer, 12 USPQ2d 1653 (BdPatApp & Inter 1989).

Conclusion: Claims 1-18 and 20-32 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. **A body having a dimension**, with an exterior surface that is ergonomically shaped to generally conform to being carried and held in one hand of the user while the user's other hand removes an article, **which is critical or essential to the practice of the invention**, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

HEADING B: Claims 1-18 and 20-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. What is an ergonomically shaped exterior surface? What does generally conform mean?

In response the applicant discloses, "Claims are not invalid for failing to comply with the requirements of the second paragraph of 35 U.S.C. § 112, provided the claims reasonably apprise those skilled in the art both of the utilization and scope of the invention, and the language is as precise as the subject matter permits... Hence, applicant's portable carrying case that has a body that has "an exterior surface that is ergonomically shaped" means that the exterior surface of the body is designed and arranged to interact with people most efficiently and safely... the person of ordinary skill

can discern readily what is meant by “generally conform”... Thus, applicants respectfully submit that the use of the phrases “ergonomically shaped exterior surface” and “generally conform” do not render applicants’ claims indefinite.. For the reasons above applicants respectfully submit that claims 1-18 and 20-32 are patentable under 35 U.S.C. 112, second paragraph.”

Rule: A claim must particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Analysis: In claims 1 and 20, the applicant describes the invention in terms of a particular user. Yet, the particulars of the user are not pointed. The claim is vague because there is no known standard to ergonomically shape a device in order to generally conform a device to be carried and held in one hand. Therefore, whether a device falls within the scope of the claim cannot be ascertained until a particular user engages the device.

Conclusion: Consequently, the claims are indefinite. Ex parte Brummer, 12 USPQ2d 1653 (BdPatApp & Inter 1989).

HEADING C: Claims 1-5, 7, 8, 11-13, and 16-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Borrero (USP 6,799,695).

The applicant argues regarding claim 1 that the invention described by Borrero is not portable because it is mounted to a wall.

Rule: The word “portable” is only in the preamble. Therefore, the device only has to be capable of being used in such a manner.

Analysis: How did the device get on the wall? When the device is mounted it is carried and therefore portable.

Conclusion: Borrero anticipates Claim 1.

HEADING D: The applicant argues regarding claim 2 that the invention described by Borrero fails to disclose a manual "push structure (32 and 42) defined in said second wall (30)."

Rule: The structure of the device must disclose each and every element to anticipate the claim.

Analysis: The device disclosed by Borrero by orienting a particular view of Figures 2-3 and 6-10 portrays a manual push structure (32 and 42) defined in said second wall (30) along with all of the other claimed elements.

Conclusion: Borrero anticipates Claim 2.

HEADING E: The applicant argues regarding claims 3 and 4 that the invention described by Borrero fails to disclose any push structure in the back wall 30.

Rule: The structure of the device must disclose each and every element to anticipate the claim.

Analysis: The device disclosed by Borrero by orienting a particular view of Figures 2-3 and 6-10 portrays a manual push structure (32 and 42) defined in the back wall (30) along with all of the other claimed elements.

Conclusion: Borrero anticipates Claims 3 and 4.

HEADING F: The applicant argues regarding claim 8 that the invention described by Borrero fails to disclose an access opening having a restricted size so as to prevent removal of said bottommost article through said access opening.

Rule: Anticipation requires that a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention.

Analysis: The device disclosed by Borrero by orienting a particular view of Figures 2-3 and 6-10 portrays an access opening having a restricted size so as to prevent removal of said bottommost article through said access opening. The lid closing the access opening may be configured to be held in such a way as to restrict the size of the opening and prevent removal of said bottommost article through said access opening.

Conclusion: Borrero anticipates Claim 8.

HEADING G: The applicant argues regarding claim 6 that Yamada fails to correct the deficiencies noted above in Borrero and that the only motivation to substitute the slidable lid is the applicant's disclosure.

Rule: A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Analysis: Yamada discloses a slidable lid which is commonly used for the purpose of covering and uncovering a dispensing opening.

Conclusion: Claim 6 is not patentable over Borrero in view of Yamada.

HEADING H: The applicant argues regarding claim 9 that Pehr fails to correct the deficiencies noted above in Borrero.

Rule: A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Analysis: Borrero anticipates Claims 1 and 8.

Conclusion: Claim 9 is not patentable over Borrero in view of Pehr.

HEADING I: The applicant argues regarding claim 10 that Amundson et al. fail to correct the deficiencies noted above in Borrero and that the only motivation to substitute the translucent elastic material is the applicant's disclosure.

Rule: A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Analysis: Amundson et al. disclose translucent elastic material which is commonly used for the purpose of providing an indication of quantity. Furthermore, the

selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art.

Conclusion: Claim 10 is not patentable over Borrero in view of Pehr and Amundson et al.

Applicant's arguments, see Appeal Brief, filed 5/10/2007, with respect to claims 14, 15, and 20-32 have been fully considered and are persuasive. The rejections under 35 U.S.C. 103(a) of claims 14, 15, and 20-32 have been withdrawn.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

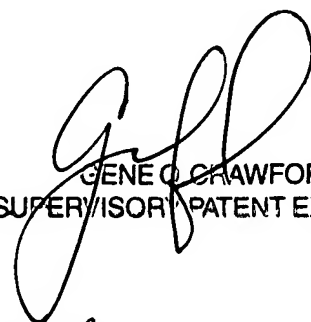
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GENE O. CRAWFORD
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8/17/2007